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ANN R. POKALSKY  
DILWORTH & BARRESE  
333 EARLE OVINGTON BLVD.  
UNIONDALE, NY 11553

**COPY MAILED**

**DEC 27 2006**

**OFFICE OF PETITIONS**

In re Application of :  
Thomas Schmulling et al :  
Application No. 10/014,101 : DECISION GRANTING PETITION  
Filed: December 10, 2001 : UNDER 37 CFR 1.313(c)(2)  
Attorney Docket No. 1187-26 :

This is a decision on the petition, filed December 22, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.


The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

*Petitioner is advised that the issue fee paid on December 12, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>*

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1638 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

  
Frances Hicks  
Petitions Examiner  
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Dec10\014101.wpd

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<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B - Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment.



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**DEC 27 2006**

**OFFICE OF PETITIONS**

In re Application of  
Thomas Schmulling et al  
Application No. 10/014,101  
Filed: December 10, 2001  
Attorney Docket No. 1187-26

:  
:  
: DECISION ON PETITIONS  
: UNDER 37 CFR 1.78(a)(6)  
: AND 37 CFR 1.55(c)

This is a decision on the petition, filed December 22, 2006, which is properly treated as a petition under 37 CFR 1.78(a)(6) and 37 CFR 1.55(c) to accept an unintentionally delayed claim under 35 U.S.C. §§ 119(e) and 119(a)-(d) for the benefit of priority to the prior-filed applications set forth in the concurrently filed amendment and declaration, respectively.

A claim for benefit of priority was previously made under 35 U.S.C. § 120 and 365(c) to Application No. PCT/EP01/06833, filed June 18, 2001 and under 35 U.S.C. § 119(a)-(d) to foreign Application No. 00870132.8, filed June 16, 2000. The petition now seeks to additionally claim benefit of priority under 35 U.S.C. 119(e) to provisional Application No. **60/258,415**, filed December 27, 2000, and under 35 U.S.C. § 119(a)-(d) to foreign Application No. **EP 01870053.4**, filed March 16, 2001.

**As to the benefit claim under 37 CFR 1.78(a)(6):**

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) and (iii) to the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the subject nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application(s) as required by 37 CFR 1.78(a)(5)(ii). Further, the application(s) claiming the benefit of the prior-filed provisional application(s) must have been filed within twelve months of the filing date of the prior-filed provisional application(s).

All requirements being met, the petition to accept an unintentionally delayed claim for benefit of priority under 37 CFR 1.78(a)(6) is **GRANTED**.

**As to the benefit claim under 37 CFR 1.55(c):**

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date, and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Director may require additional information where there is a question whether the delay was unintentional); and
- (5) the application claiming benefit of priority must be filed within 12 months of the filing date of the foreign application.

All requirements being met, the petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for benefit of priority under 35 U.S.C. § 119(a)-(d) is **GRANTED**.

**The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(6), and 37 CFR 1.55(c) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and 1.78(a)(5), and 35 U.S.C. 119(a)-(d) and 37 CFR 1.55(a)(1) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this**

**benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.**

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

It is noted that the claim for foreign priority appears in the amendment to the first line of the specification following the title. However, petitioner is reminded that inclusion of the claim for benefit of priority to a foreign application is more appropriately made in either an Application Data Sheet or in an oath or declaration. Additionally, as a claim for benefit of priority under 35 U.S.C. §§ 120 and 365(c) was made to Application No. PCT/EP01/06833, it should not also appear under the foreign priority data under 35 U.S.C. § 119(a)-(d) in the oath or declaration.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center Art Unit 1638 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. §§ 119(e) and 119(a)-(d) to the prior-filed applications.



Frances Hicks  
Petitions Examiner  
Office of Petitions

**ATTACHMENT:** Corrected Filing Receipt



## UNITED STATES PATENT AND TRADEMARK OFFICE

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 United States Patent and Trademark Office  
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/014,101	12/10/2001	1638	3020	1195-2	16	137	11

CONFIRMATION NO. 2633

Ann R. Pokalsky  
 DILWORTH & BARRESE  
 333 Earle Ovington Blvd.  
 Uniondale, NY 11553

## CORRECTED FILING RECEIPT



\*OC000000021741708\*

Date Mailed: 12/27/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

## Applicant(s)

Thomas Schmulling, Berlin, GERMANY;  
 Tomas Werner, Berlin, GERMANY;

## Power of Attorney:

Ann Pokalsky--34697

## Domestic Priority data as claimed by applicant

This application is a CIP of PCT/EP01/06833 06/18/2001  
 which claims benefit of 60/258,415 12/27/2000

## Foreign Applications

EUROPEAN PATENT OFFICE (EPO) 00870132.8 06/16/2000  
 EUROPEAN PATENT OFFICE (EPO) 01870053.4 03/16/2001

If Required, Foreign Filing License Granted: 01/29/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US10/014,101**

Projected Publication Date: Not Applicable

Non-Publication Request: No



**Early Publication Request: No**

**Title**

METHOD FOR MODIFYING PLANT MORPHOLOGY, BIOCHEMISTRY AND PHYSIOLOGY

**Preliminary Class**

800

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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**LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted

under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).